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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,864

12/24/2003

Hideyuki Nojiri

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

02/04/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/743,864	<b>Applicant(s)</b> NOJIRI, HIDEYUKI	
	<b>Examiner</b> ANISH DESAI	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/03/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-61 is/are pending in the application.
- 4a) Of the above claim(s) 41,42,48,55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39,40,43-47,49-54 and 57-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***DETAILED ACTION***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 12/03/09 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/0/09 has been entered.
2. In view of applicant's amendment, a new 112-first and second paragraph rejections are made.
3. After reviewing applicant's amendment, arguments, and the prior art of Honda (US 4,589,432) are withdrawn, given that Honda does not teach "an entirety of the adhesive layer has adhesiveness sufficient to prevent the string member from being detached from adhering portion...recoiled back toward the unstretched state to form the double eyelid" as presently claimed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 39, 40, 43-47, 49-54, and 57-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

5. With respect to claims 39, 45, and 51, said claims recite "...and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the tape member [or string member or elongate member]" (claims 39, 45, 51), "...break the skin of the eyelid from a surface of an eyeball" (claims 39, 45, 51), "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the tape member [or the string member] from being detached from adhering portions on the skin on the eyelid when...to form the double eyelid" (claims 39 and 45), and "the adhering portion of the adhesive layer has an adhesiveness sufficient to prevent elongate member from being detached from adhering portions on skin on the eyelid when...to form the double eyelid" (claim 51). It is submitted that specification fails to provide support for the aforementioned claim limitations.

6. Applicant points to page 10, lines 2-9 and 18-25, at page 12, lines 6-44, and at page 12, line 21 to page 13, line 2 for support. However, the Examiner respectfully

submits there is no support to in the specification for aforementioned newly added limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**7. Claims 39, 40, 43-47, 49-54, and 57-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

8. Claims 39, 45, and 51 recite that the tape member (or string member) is configured to break the skin of the eyelid from a surface of an eyeball...This recitation is confusing as it is not clear as to what is meant by break the skin of the eyelid. Does applicant want to convey that the part of the skin lifts from the eyelid in order to form a fold on the eyelid?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9. Claims 39, 40, 43, 44, 51-54, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835).**

10. It is noted that claims 39 and 51 recite "a double eyelid forming article of manufacture for forming a fold on an eyelid of a user", "configured to be adhered onto an eyelid in a stretched state along a longitudinal direction to form a double eyelid", and "the tape member in the stretched state is configured to have a resilient shrinkability larger than tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in the direction perpendicular to the longitudinal direction of the tape member...break the skin of the eyelid from a surface of an eyeball to form the fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward the unstretched state", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the...to form the double eyelid". It is respectfully submitted that the aforementioned recitations are intended use of the article, while some of the recitations are functional, it is submitted that if a structure and composition of the prior art article is same as claimed by the applicant's article, then the prior art article is functionally capable of meeting the aforementioned recitations.

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11. Based on the above, any reference disclosing a tape member that is resiliently stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other "long the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

12. Hodgson discloses adhesive materials for use on animal bodies especially human bodies for surgical, dermatological or cosmetic use. The examples include surgical drapes, adhesive dressings, strips and sheets, and eyeliners (Column 2. lines 74-75, Column 3. lines 1-5). Additionally, according to Hodgson another preferred use of the present invention is in surgical drapes. These are large flexible sheets, which are provided with a continuous layer of adhesive on at least a part only of one surface (column 7, lines 64-67). Further, at column 1 lines 25-30, Hodgson discloses "According to the present invention...a backing material having a pressure-sensitive adhesive on at least substantially the whole of the body-adhering portion of at least one

surface of said backing material". This disclosure of applying the adhesive on at least one surface of the tape is interpreted as that adhesive layer can be applied on the both surfaces of the tape member, and it reads on the claim requirement of "at least one of the first surface or the second surface has an adhesive layer covering an entirety of the first surface or the second surface".

13. Additionally, the adhesive drape of Hodgson as shown in Figure 7 has a backing layer 2 having an adhesive coating 4 on the surface of the backing layer. Further, the adhesive 4 is covered by a protector 6 (column 10, lines 27-31). The backing layer 2 of Hodgson is preferably formed of a polyurethane film (column 8, lines 5-6). At column 5, lines 69-74, Hodgson discloses Estane 5701 and 5702 brand thermoplastic polyurethane films, which is a polyurethane elastomeric film as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). The elastic backing layer 2 of Hodgson having an adhesive coating 4 is equated to a resiliently stretchable elongate tape member.

14. The adhesive tape member of Hodgson, as shown in Figure 7 has "the a first surface and a second surface" that "elongate consistently along the entire longitudinal direction of the tape member while these surfaces are oppositely faced to each other" and "the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the tape

member when the tape member is in an unstretched state". Additionally, if one were to examine the cross-section of the adhesive tape member of Hodgson as shown in Figure 7, it would read on "cross sections of the first surface...is in the unstretched state, the cross sections each have uniform form along the whole longitudinal direction...is in the unstretched state".

15. As to the claim requirement of "the elongate member includes a pair of holding portions configured to be held with fingers and arranged individually on a first end of the elongate member and a second end of the elongate member along the longitudinal direction", Hodgson teaches that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). Moreover, as to the claim requirement of "the elongate member includes an adhering portion", the claim does not explicitly exclude the adhering portion from being a part of the surfaces of the tape member, therefore a portion of the backing layer surface of Hodgson which is covered with an adhesive layer is equated to the "adhering portion".

16. As to the claim limitations of "the tape member in the stretched state is configured to have a resilient shrinkability larger than tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in the direction perpendicular to the longitudinal direction of the tape member...break the skin of the eyelid from a surface of an eyeball to form the fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling

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back toward the unstretched state", and "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the...to form the double eyelid", the Examiner submits following:

17. It is reasonable to presume that the adhesive tape member of Hodgson has the aforementioned features including "resilient shrinkability" and sufficient width and a sufficient length for forming the fold because as set forth above the adhesive tape members of Hodgson and that of applicant have similar structure and composition. Further, since Hodgson is used on skin and to produce wrinkles, it would meet the claim recitation "an entirety of the adhesive layer has an adhesiveness sufficient to prevent the...to form the double eyelid". Therefore, the aforementioned features would be present. The burden is shifted to applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594).

18. Moreover, as to the claim requirement of the arrangement of a release material on each of the adhesive layers on the first surface and the second surface. It is noted that Hodgson discloses of applying the adhesive on at least one surface of the backing (column 1 lines 25-31) and covering the adhesive layer with a silicone-coated release paper (column 6 lines 70-73 and column 7 lines 70-71).

19. Thus, it would have been obvious to provide an adhesive on the second surface of the backing and cover it with a release layer, motivated by the desire to protect the adhesive layer.

20. As to the claim requirement of the elongate member being a string member and “cross sections...arcuate shapes...unstretched state”, it is noted that the invention of Hodgson is used in surgical drapes, suture strips...solid eye liners etc. (column 3 lines 1-5). Further, Hodgson discloses the size and the shape of the suture strips may of course be varied as desired (column 8 lines 44-53). Therefore, choosing a shape the tape member in the form of a string having outwardly protruding arcuate shapes involves routine skill in the art.

21. **Claims 45, 46, 50, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clavin (US 4, 653, 483).**

22. It is respectfully submitted that recitations “a double eyelid forming article of manufacture for forming a fold on an eyelid of a user”, “configured to adhere to the eyelid in...to form a double eyelid”, and “wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the string member...to break the skin of the eyelid from a surface of an eyeball...recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid”, and “an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the

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unstretched state to form the double eyelid" are intended use of the claimed article.

While some of these recitations are functional in nature, it is respectfully submitted if a structure and composition of the prior art article is same as claimed by applicant's article, then the prior art article is capable of functioning the intended use as presently claimed.

23. Based on the above, any reference disclosing a string member that is resiliently stretchable (i.e. elastic) having "a first and second surface to elongate consistently along the entire longitudinal direction of the same member while these surfaces are oppositely faced to each other", "the first surface and the second surface...pair of side edges that consistently elongate...the entire longitudinal direction of the tape member", "the individual side edges of the first surface and the second surface...forms in parallel to each other "long the whole longitudinal direction...when the tape member is in an unstretched state, cross sections of the first surface...uniform form along the whole longitudinal direction...when the tape member is in the unstretched state...the first surface and the second surface each have an adhesive layer...entirety of the first surface and the second surface, the tape member has a consistent...along the entire longitudinal direction", will read on the claims.

24. Clavin discloses an adhesive tape having a backing and a layer of adhesive on each side of the adhesive tape (see abstract, Figure 15 and column 5 lines 1-5). As to the claim requirement of "string member", it is noted that Applicant has generally recited "a string member" but not provided any dimension (e.g. diameter, length etc.) of a string

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member nor defined what is meant by "string member". It is noted that Calvin's tape is applied to an eyelid to retain a fold in the skin thereof (column 1 lines 10-15). Further, Clavin discloses that "According to the present invention, a very thin strip of double-sided adhesive tape 32 generally **less than 1 cm in width** and 4 cm in length is attached to the upper eyelid 10 (column 3 lines 50-55). This disclosure of Clavin reads on a string member as claimed.

25. Further, the backing film of Clavin is formed of polyethylene (see column 5 lines 39-45), which meets claim 60. The polyethylene backing of Clavin reads on the resiliently stretchable elongate string member as required by the presently claimed invention. As to the claim requirements of "first surface and the second surface...oppositely faced to each other", "the first surface and the second surface each have a pair of side edges...of the string member", "the individual side edges are each in liner forms in parallel to each other...in an unstretched state", "cross sections of the first surface...outwardly protruding arcuate shapes...when the string member is in the unstretched state...the cross sections each have a uniform form along the whole...in the unstretched state", these limitations are disclosed in Figure 13 (e.g. arcuate shape of the cross section) and Figure 15 or obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can suitably be applied to eyelids.

26. As to the claimed features of “wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the string member...to break the skin of the eyelid from a surface of an eyeball...recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid”, and “an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid”, and “a first end of the string member and a second end of the string member...a part configured to be removed after the double eyelid is formed” (claim 50), it is reasonable to presume that said features are necessarily present in the string member of Clavin.

27. Support for said presumption is based on the fact that as stated above the string members of Clavin as set forth above and that of applicant are structurally and compositionally equivalent. Therefore, said claimed features would be present. Additionally, as to the claim requirement of the “an entirety of the adhesive layer has an adhesiveness sufficient to prevent the string member from being detached from adhering portions on the skin on the eyelid when the string member is adhered to the eyelid in the stretched state and subsequently recoiled back toward the unstretched state to form the double eyelid”, the Examiner submits that since Clavin’s article is

applied to an upper eyelid to retain a fold in the skin thereof (see Background of The Invention of Clavin), Clavin meets this limitation. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

28. As to the claim requirement of the release material in a consistent and integral form, it would have been obvious to provide a release material in consistent and integral form, motivated by the desire to protect the adhesive layers.

**29. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calvin (US 4,653,483) as applied to claim 45 above, and further in view of Samuelsen et al. (WO 99/38929). US 6,482,491B1 to Samuelsen is relied upon for convenience.**

30. The invention of Clavin is previously disclosed. Clavin is silent as to teaching the individual release materials each include an arcuate groove along a surface of each of the adhesive layers.

31. However, Samuelsen discloses an article having a surface showing adhesive properties and a cover layer (release layer) for protecting the adhesive surface (abstract). Additionally, the release layer of Samuelsen has indentations in the forms of grooves, ridges, bulges, bumps etc. (column 2 lines 22-26 and column 4 lines 20-35). This disclosure of Samuelsen reads on the release material having an arcuate groove as claimed. It would have been obvious to one having ordinary skill in the art at the time

the invention was made to use the release materials having arcuate groove, motivated by the desire to easily remove the release materials.

**32. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clavin (US 4,653,483) as applied to claim 45 above, and further in view of Hodgson (US 3,645,835).**

33. Clavin does not explicitly teach "a first end of string tape member and a second end of the string member...holding portions configured to be held with fingertips, and the holding portions have no adhesive property or have a suppressed adhesive property".

34. However, the invention of Hodgson is previously disclosed. Hodgson discloses that the two edges 24 of the backing material 2 are left uncoated (column 10, lines 31-32). The uncoated areas on the backing layer of Hodgson reads on a holding portion as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide holding portion having no adhesive property such that the string member can be handled easily during its application to an eyelid by a user and such arrangement would prevent user accidentally touching the adhesive layer and potentially contaminating the adhesive.

**35. Claims 59 and 61 are under 35 U.S.C. 103(a) as being unpatentable over Hodgson (US 3,645,835) as applied to claims 39 and 51, and further in view of Berglund et al. (US 4,310,509).**

36. Hodgson is silent as to teaching polyethylene. However, Berglund discloses a PSA having antimicrobial material in it. Further at column 4 lines 30-40; Berglund discloses that the homogeneous dispersion [i.e. adhesive] is coated onto various backings to form dressings, drapes, tapes, etc. The preferred backing material is polyethylene.

37. It is noted that Hodgson's invention is directed to PSA that are used in dressings, plasters, adhesive bandages etc. (column 1 lines 5-15). Hodgson is silent as to teaching polyethylene. Secondary reference of Berglund provides polyethylene that can be used in adhesive tapes, dressings etc.

38. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the polyethylene backing as taught by Berglund and used as a backing in the invention of Hodgson, because selecting a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness.

***Response to Arguments***

39. Applicant's arguments filed on 12/03/09 have been fully considered but they are not persuasive.

40. As to applicant's arguments on pages 15-16 of the amendment against Hodgson reference (US 3645835), the Examiner submits following:

41. While Hodgson does not explicitly teach of producing a double eyelid on the skin of an eyelid, as set forth in this OA, this feature necessarily results from the disclosure of Hodgson (please see rejection under Hodgson). Further, as to applicant's argument that the surgical drape of Hodgson can produce wrinkle for example, on a forearm, without producing a double eyelid on the skin of the eyelid, said argument is not persuasive given that there is no factual evidence on the record to support the argument.

42. Additionally, as to applicant's arguments that while Hodgson describes wrinkle on the skin; but no evidence has been provided that same resilient shrinkability to form....(see page 16 of the amendment), the Examiner submits following:

43. The adhesive drape of Hodgson as shown in Figure 7 has a backing layer 2 having an adhesive coating 4 on the surface of the backing layer. Further, the adhesive 4 is covered by a protector 6 (column 10, lines 27-31). The backing layer 2 of Hodgson is preferably formed of a polyurethane film (column 8, lines 5-6). At column 5, lines 69-

74, Hodgson discloses Estane 5701 and 5702 brand thermoplastic polyurethane films, which is a polyurethane elastomeric film as evidenced by US 2007/0066185A1 to Felipe (paragraph 0058). Further, Hodgson teaches a use of elastic backing material (column 10, lines 38-39). The elastic backing layer 2 of Hodgson having an adhesive coating 4 is equated to a resiliently stretchable elongate tape member. Given that Hodgson and applicant both use elastic material and the fact that Hodgson describes wrinkle on the skin (see applicant's response on page 16 of the amendment), it is reasonable to presume that wrinkle on the eyelid would be formed.

44. As to applicant's arguments on page 15 of the amendment (last full paragraph), the Examiner submits that the support for the Examiner's position in section 15 on page 8 of the 09/03/09 OA is based on the disclosure of Hodgson as set forth in sections 8-13 on pages 5-8 of the aforementioned OA. Accordingly, applicant's arguments are not found persuasive.

45. As to applicant's arguments on pages 16-17 of the amendment against Clavin (US 4653483), the Examiner submits following:

46. With respect to applicant's argument that Clavin is silent with regards to first stretching the tape, and then allowing the resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the tape returns to its original size, the Examiner submits following: it appears that applicant's arguments are based on the

assumption that applicant's claimed tape is in contact with the skin of the eyelid.

However, claims as presently recited do not require that the double eyelid forming article is positively in contact with the skin of an eyelid. Additionally, the Examiner submits that Clavin's adhesive tape and applicant are formed of same material namely polyethylene (see column 5 lines 39-45). Therefore, the tape of Clavin is necessarily stretchable and has resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the tape returns to its original size.

47. As to applicant's arguments that while Clavin describes that the adhesive strip can be formed of polyethylene; there are many different types of polyethylene with different structural properties such that the adhesive strip of Clavin does not inherently have resilient shrinkability larger than a tension of the skin, the Examiner submits following: while applicants argue that not all polyethylene have resilient shrinkability larger than tension of the skin, applicants have provided no evidence to support this position.

48. With respect to applicant's arguments (see page 17 of the amendment) that "Further, it is noted that increased force would be placed on the adhesive layer during shrinkage as compared the adhesive strip 32 of Clavin...Thus, there is no disclosure in Clavin that the adhesive strip 32 could hold onto the skin during the shrinking.", the Examiner notes that applicant's arguments are presented without any factual evidence on the record. As such, the arguments are not found persuasive.

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49. Further, as to applicant's arguments on pages 17-18 that a person of ordinary skill in the art reading Clavin would understand that it is necessary to stick the adhesive tape to the eyelid along the three-dimensional shape of the eyeball, thus a curve of at least a portion of the side edges is an indispensable requirement in Clavin and the tape with linear side edges entirely parallel to each other is not a part of the double eyelid forming product, the Examiner submits following: as set forth in this OA, there appears to be no teaching or suggestion in Clavin that at least a portion of the side edges **must** be curved. Further, in absence of unexpected results providing a tape having linear side edges that are entirely parallel to each other would have been obvious modification recognized by one of ordinary skill in the art who is in possession of Clavin given that Clavin and applicant's tape are applied generally in the same area (i.e. skin of eyelid). Accordingly, applicant's arguments are not found persuasive.

### ***Conclusion***

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

51. US Patent 7484846B2 to Souwapawong discloses double eyelid forming devices.

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52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

53. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

54. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794